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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
OLEG STENZEL, ET AL. : EXAMINER: HANOR, S. L.
SERIAL NO: 10/523,029 :
FILED: SEPTEMBER 7, 2005 : GROUP ART UNIT: 1793
FOR: HIGHLY DISPERSIBLE :
PRECIPITATED SILICA :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated July 21, 2009 (Answer), supplemented by corrections to (c)(6) of the Answer mailed August 24, 2009.

Applicants acknowledge the Examiner's withdrawal of the rejections listed under Grounds (B) and (C) in the Appeal Brief (Answer at 3). Applicants also acknowledge the Examiner's correction of the error in the Appeal Brief of the actual patent number of Uhrlandt et al (Answer at 2). Applicants would also like to acknowledge an error in the Appeal Brief, in which the rejected claims over Uhrlandt et al were incorrectly listed as Claims 1-4 and 11-28. The rejected claims are Claims 1-4 and 21-28.

The statement of the Grounds of Rejection, to the extent relevant to issues to be decided by the Board (Answer at 4-8) is identical to the statement in the Final Rejection, which has already been responded to in the Appeal Brief. The following is in reply to the Response to Argument (Answer at 8-12).

The Examiner cites precedent to the effect that a patent as prior art is not limited to its examples or preferred embodiments but for all relevant information which it may contain (Answer at 9). The Examiner continues that one of ordinary skill in the art “could have reasonably selected and optimized the claimed properties from the prior art to make the instant invention” (*Id.*)

In reply, the Examiner’s position proscribes any possibility of demonstrating patentability for a sub-genus invention over a genus disclosed in the prior art. Indeed, that is not the law. See, for example, *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

In addition, as Applicants previously pointed out in the Appeal Brief, Uhrlandt et al is directed to improving dispersibility of precipitated silica in rubber mixtures. Accordingly, Applicants do not question that one of ordinary skill in the art would have been able to optimize the parameters of the precipitated silica of Uhrlandt et al to optimize such dispersibility. But since Uhrlandt et al discloses and suggests nothing with regard to the sub-genus of tires intended for commercial vehicles such as trucks, motor bikes, and high-speed automobile tires, or the significant property of high-temperature tear resistance when used for such tires, it clearly would not have been obvious to optimize these parameters, i.e., BET surface area, CTAB surface area, etc., for this property, without the present disclosure as a guide.

Regarding Applicants’ argument that the presently-claimed silicas are intended for commercial vehicle tires, which tires have a requirements profile different from that of passenger car tires, the Examiner repeats the finding that the claims are drawn to a silica, not to tires (Answer at 9-10).

In reply, Applicants have already responded to this finding in the Appeal Brief, which response is still maintained.

In response to Applicants' arguments about the data presented in the Wehmeier Declarations, the Examiner finds that the examples of Uhrlandt et al cannot be compared to the present invention "because none of the examples of Uhrlandt et al. have all the parameters within the instantly claimed ranges" (Answer at 10 and 11). In reply, Applicants have compared to the example of Uhrlandt et al that is closest to the presently-claimed invention, as affirmed by Wehmeier. The Examiner's rationale appears to be that Applicants should have compared the present invention with the present invention! *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 "would be requiring comparison of the results of the invention with the results of the invention." 148 USPQ at 714.)

In response to Applicants' argument that the property of superior high-temperature tear resistance that the presently-claimed silica imparts to a tire has been shown to be an inherent property of the silica and therefore need not be recited in the claims, the Examiner finds that Applicants have "failed to show that the silica of Uhrlandt et al. does not possess said inherent property," and repeats the previous finding that Uhrlandt et al's examples cannot be compared to because none of them have all the parameters within the presently-recited ranges (Answer at 11).

In reply, Applicants have shown that the closest prior art example of Uhrlandt et al does not inherently possess the tear resistant properties of the presently-claimed silica. Again, the Examiner's erroneous rationale appears to be that Applicants should be comparing the present invention to the present invention.

With regard to the obviousness-type double patenting rejection over Uhrlandt et al, the Examiner finds that "the claims and disclosure of Uhrlandt et al. present a clear case of prima facie obviousness" (Answer at 12).

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In reply, only the claims of Uhrlandt et al are relevant to this rejection. Applicants otherwise maintain the arguments made in the Appeal Brief.

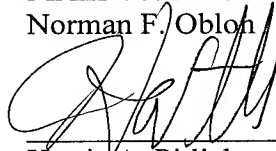
Applicants continue to maintain that all of the remaining rejections should be REVERSED.

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Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'H. Pitlick', is written over a horizontal line.

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